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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,641

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Ronald Brian Smith

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09/26/2006

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EXAMINER

ELKINS, GARY E

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/762,641

Applicant(s)

SMITH ET AL.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7,9,11-13,16,18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4-6,11,12,16 and 22 is/are allowed.
- 6) ☒ Claim(s) 1,7,9,13,18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiments as set forth in claims 7 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. Claims 7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to provide enablement for the embodiment in claims 7 and 9 where the detached upper member and leg member each “are operatively related to have a second combined function as a novelty item” and where the second function of the detached upper portion is either a wearable jewelry item or a picture frame.

3. Claims 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 7 and 9, it is unclear how the detached upper member and the leg member are each “are operatively related to have a second combined function as a novelty item” when the second function of the detached upper member is a wearable jewelry item (cl. 7) or a picture frame (cl. 9). No description can be found in the specification for either of the embodiments of claim 7 or 9 as now claimed.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by either Wall (fig. 5 emb) or Gould.

Wall discloses a device with an upper member 102 and a leg 112 connected by a connecting means, i.e. the section of material connecting the leg to the upper member. The connecting means in Wall is considered a “thin-walled member” insofar as the section of material is thinner than the wall of the upper member in Wall. The leg is considered to be capable of being detached by breaking the leg from the upper member. No distinction is seen between the claimed device and that shown in Wall as a result of the claimed operative relationship of the leg member and the upper member when they are detached, i.e. the leg member and upper member could be used, e.g. as a toy cauldron with the leg member forming a stirring stick.

Gould discloses a device including an upper member 20 and at least one leg 26 detachably connected to the upper member by connecting means 24 which constitutes a thin-walled member. No distinction is seen between the device claimed and that of Gould as a result of the claimed operative relationship of the detached upper member 20 and the leg, i.e. the upper member 20 is considered capable of being used as a top via the permanently connected member 26 and the leg 26 (along with the section 22) could be used as a target for the child or user to aim the top at.

6. Claims 1 and 20, and claim 9, as best understood in view of paragraphs 1-3 above, are rejected under 35 U.S.C. 102(e) as being anticipated by Steck et al. Steck et al discloses a device including an upper member 3 and a leg 5. The upper member includes a raised portion around a central area which is considered to be capable of receiving a picture and acting as a picture

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frame. Also, the connecting portion or member between the leg and the upper member 3, i.e. the bond is considered to be thin-walled as claimed. With respect to claim 20, the upper member 3 in Steck et al is planar and formed in one piece as claimed. With respect to claims 1 and 9, it is noted that no distinction is seen between the device claimed and that in Steck et al as a result of the claimed operative relationship of the detached upper member 3 and the at least one leg 5, i.e. each member could be used, e.g. as a toy creating an impression in play-dough by a child or they could be used to hold portions of a picture in each framed portion.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13, 18 and 21, and claim 7, as best understood in view of paragraphs 1-3 above, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould in view of Beck et al. Gould discloses all structure of the claimed device except formation of indicia on the upper member. Beck et al teaches that it is known to make a container support with indicia on the upper flat portion of the upper surface. It would have been obvious to make the upper member in Gould with indicia as taught by Beck et al to enhance the advertising effect of the device. No distinction is seen between the claimed device and that of Gould as a result of the claimed intended use of the device, when separated, as a flyable disc, wearable jewelry, miniature toy or spinnable top, i.e. the disc 20 in Gould is considered capable of being used as any one of these items. With respect to the intended use as wearable jewelry, it is noted that the permanent leg 26

in Gould could be inserted within a button hole of a shirt. With respect to the intended use as a miniature toy, it is noted that a miniature toy is considered to be any small item with which a child can play.

***Allowable Subject Matter***

9. Claims 2, 4-6, 11, 12, 16 and 22 are allowed.

***Response to Arguments***

10. Applicant's arguments filed 27 June 2006 have been fully considered but they are not persuasive.

With respect to the patent to Wall, the remarks assert that the patent does not disclose a device including a thin-walled member interconnecting the upper member and leg member or that each of the detached upper member and detached leg member are operatively related to have a combined function as a novelty item. The assertion is also made that if a leg were detached from the container in Wall, the container would be destroyed.

In response, the section of the leg in Wall immediately adjacent the container is considered a "thin-walled member" as claimed. The section is thin-walled insofar as it has a thinner cross section than the container. The leg member is detachably connected along this section insofar as the thin-walled section is capable of being detached, e.g. by taking a knife and detaching the leg member along the section. Such detachment would not result in the container being destroyed as asserted by Applicant. The intended detachment would result in a novelty item, i.e. an item which is novel, e.g. a toy cauldron or container with a stirring stick where the functions of the leg member and the upper member are "operatively related" when such detachment is desired. As a result, no distinction is seen between the device claimed and that

shown in Wall. It is noted that the remarks appear to be indicating that, for a prior art reference to anticipate a product, it must set forth the claimed intended use. This is incorrect. Patent law is clear with respect to the fact that the patentability of a product is not dependent upon its intended use. If the prior art device meets all structural limitations within the claim and is capable of the claimed intended use, there is no distinction between the product claimed and that within the prior art.

With respect to the patent to Gould, the remarks assert that at least one of the legs in Gould is not capable of detachment along a thin-walled member and that, when detached, that the detached leg member and upper member are “operatively related to have a second combined function as a novelty item”.

In response, Gould clearly anticipates a thin-walled member 24 allowing separation of at least one of the leg members 26 from the upper member 20. The remarks appear to be asserting that since the member 22 is intermediate the thin walled member 24 and the leg 26, the leg member cannot be detached from the upper member 20. In response, claim 1 does not preclude other elements. The device is set forth as “comprising” the claimed elements. Also, the leg member in claim 1 could also include the member 22. Nothing within claim 1 precludes the leg member to being a particular shape or configuration. With respect to the intended combined function of the device when it is desired to detach the leg member and the upper member, the detached elements are capable of being used together as indicated in paragraph 5 above.

With respect to the patent to Steck et al, the remarks assert that at least one of the legs in Steck et al is not capable of detachment along a thin-walled member and that, when detached,



that the detached leg member and upper member are “operatively related to have a second combined function as a novelty item”.

In response, Steck et al discloses a thin-walled connection or member formed by the bond between one of the legs 4 and the upper member 3. No distinction is seen between the claimed thin-walled member and the connecting bond in Steck et al. With respect to the intended combined function of the device when it is desired to detach the leg member and the upper member, the detached elements are capable of being used together as indicated in paragraph 6 above. Note is also made with respect to claim 20 that the upper member 3 in Steck et al is clearly “one-piece” as is now claimed.

### ***Conclusion***

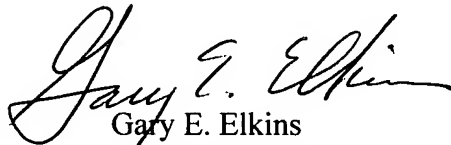
In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (571)273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. Also, copies of an office action or other file information may be obtained from the Private PAIR system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday through Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Nathan Newhouse can be reached at (571)272-4544.

  
Gary E. Elkins  
Primary Examiner  
Art Unit 3727

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15 August 2006